

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	09/176,639	Confirmation No. 2112
Applicant	:	Richard Robert SCHEDIWY et al.	
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TC/A.U.	:	2629	
Examiner	:	Kumar, Srilakshmi K.	
Docket No.	:	028.1108	
Customer No.	:	69819	

ARGUMENTS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

I. Status of Claims

Claims 24 and 52 - 96 are currently pending in the application and under appeal.

II. Rejections under 35 U.S.C. § 112

In the office action, claims 24, 52-96 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner cited to the phrase “wherein the conductive touch layer has a conductivity configured to create an image of said conductive object that is larger than an area of contact of said conductive object” in independent claim 52, and similar language in independent claims 24, 63, 68 and 88.

In making this rejection the Examiner alleged that the specification does not adequately disclose how the “conductivity is configured to create an image of said conductive object that is larger than an area of contact of said conductive object”. The Examiner notes that the specification teaches “For best operation, the conductivity of the surface layer should be chosen such that the image of the stylus is about the same size as the image generated by a finger on a normal capacitive sensor.” However, the Examiner then alleges that the

specification does not teach how the conductivity is chosen or selected as claimed in the independent claims. The Examiner then concludes by stating that “The claims are indefinite since it can not be determined how the conductivity is configured to create an image of said conductive object that is larger than an area of said conductive object.”

Applicants respectfully disagree, and submit that the claims meet the requirements of 35 U.S.C. 112, second paragraph. First, applicants submit that the Examiner is misstating the test for definiteness under section 112, second paragraph. As noted in the MPEP at 2173, the “The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent.” The MPEP 2173.02 further states that “The essential inquiry pertaining to this requirement is **whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity**” (emphasis added). Furthermore, the MPEP 2173.02 additionally states that claim language must be analyzed in light of the “content of the particular application disclosure”, the “teachings of the prior art”, and the “claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.”

Applicants submit that the Examiner has failed to apply the correct test for indefiniteness under U.S.C. 112 second paragraph. Specifically, the Examiner has failed to make a proper analysis of the claim language, content of the disclosure, and teachings of the prior art, and has thus failed to provide the required *prima facie* case of obviousness. For example, the Examiner has failed to point to any specific language in the claims that is unclear as to meaning, or how one skilled in the art would be unable to determine **the bounds the claim with a reasonable degree of clarity and particularity**.

Instead, the Examiner seems to rely exclusively on an alleged lack of adequate enabling disclosure in the specification, with particular focus on the term “moderate conductivity”. Applicants again note that this is clearly not the correct test for definiteness under 35 U.S.C. 112 second paragraph, as the above language from the MPEP 2173.02 makes clear.

Furthermore, applicants submit that when a correct analysis is performed that the claims clearly meet the requirements 35 U.S.C. 112, second paragraph. In the instant case, all the terms in the allegedly indefinite phrases are absolutely clear as to meaning, and the Examiner has made no allegation otherwise. Furthermore, regarding the conductivity of the top layer in general, and the use of the “moderate conductivity” in particular, applicants note that the specification teaches that:

- The conductive touch layer has a moderate conductivity that spreads out the ground image of the tip of the stylus (see applicant’s specification at page 8, lines 25-31).
- A suitable material for this purpose is a conductive carbon powder in a plastic carrier material such as epoxy (page 9, lines 1-13).
- The moderate conductivity of the material causes the effect to dissipate with distance from the point of contact with the stylus (page 9, lines 8-13).
- By controlling the conductivity of layer 501, the image of the stylus tip can be adjusted to provide a sufficient signal on an appropriate number of electrodes (page 9, lines 14-17). This effect is also illustrated in FIG. 6.
- If the conductivity is too large, the image will be very large, possibly even covering the entire surface of the pad (page 9, lines 19-23). This effect is also illustrated in FIG. 7.
- If the conductivity is too small, the image will not be much larger than the tip of the stylus (page 9, lines 30-33). This effect is also illustrated in FIG. 8.
- The specification teaches that for one embodiment, the conductivity of the surface can be chosen for best operation such that the image of the stylus is about the same size as a finger would be on a normal capacitive sensor (see page 10, lines 3-6, and the similarity between graph 205 of FIG. 2 and graph 506 of FIG. 6). The specification also gives as an example the increasing of area by a factor of four (see page 12, lines 4-12).

Furthermore, we note that the use of the term “moderate” clearly defines an intermediate amount of conductivity. For example, “moderate” is defined as “tending toward the mean or average amount or dimension” (see Merriam-Webster’s Collegiate Dictionary, 11th Edition). Thus, a material having “moderate conductivity” would not have the full conductivity found in a pure metallic conductor, or the absence of conductivity found in an insulator material. Instead, a moderate conductivity describes the intermediate level of conductivity, such as that found in a described carbon impregnated epoxy.

Finally, we also note that someone with ordinary skill in capacitive sensor design would have a professional level of training in electrical engineering and physics, and would thus have a strong understanding of underlying material properties, including the conductivity of materials such as carbon impregnated epoxy.

Thus, the specification thus clearly describes a suitable material for use in the touch layer (*i.e.*, carbon powder in epoxy), describes a suitable conductivity in general (*i.e.*, moderate conductivity), and gives detailed guidance in determining what the effect of a suitable conductivity for a particular application would be (*i.e.*, selected to increase an image of a stylus by a factor of 4), in a way that would clearly be within the highly technical abilities of one of ordinary skill in the relevant art.

Finally, applicants again note that in reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). In this case, the phrase “wherein the conductive touch layer has a conductivity configured to create an image of said conductive object that is larger than an area of contact of said conductive object” as recited in independent claim 52, and similarly recited in claims 24, 63, 68 and 88, clearly set out and circumscribes the claimed subject matter with a reasonable degree of clarity and particularity, given the clarity of the language itself, the teachings of the specification, and the knowledge and training of one of ordinary skill in the art.

III. Conclusion

In view of the foregoing, it is submitted that the claims meet the requirements of the 35 U.S.C. 112, second paragraph. Hence, Applicants request that the reviewing panel find that the present application is in condition for allowance.

Respectfully submitted,

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